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By: Chianti Appling
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.

Atty Docket No: 407T-895100US
Client Ref: 98-013-1

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#26

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JAMES D. MARKS and PETER ARMERSDORFER

Application No.: 09/144,886

Filed: 08/31/1998

For: **THERAPEUTIC MONOCLONAL ANTIBODIES THAT NEUTRALIZE BOTULINUM NEUROTOXINS**

Examiner: Nita M. Minnifield

Art Unit: 1645

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is filed in response to the Communication dated July 30, 2002. The following documents are enclosed herewith:

- 1) A petition to extend the period of response for two months.

REMARKS

This paper is filed in response to the Communication dated July 30, 2002, in which the Examiner alleged that the reply filed on May 13, 2002 is not fully responsive to the prior Office action because the response to Restriction Requirement did not elect a specific SEQ ID NO as requested.

In response, Applicants elect s a species as it reads on clone C25. With respect to the Examiner's request for a specific SEQ ID NO., Applicants note that the C25 VH region is given by SEQ ID NO:63, while the C25 VL region is given by SEQ ID NO:87 (see, e.g., Table 1) and that both SEQ ID NOs are necessary to define the antibody of clone C25.

Application further note that the Examiner's allegations are improper as well as the Examiner's refusal to consider the Amendment filed on December 13, 2001.

According to MPEP §803, the Examiner should examine all claims in an application, even though they are directed to distinct inventions, **unless to do so would create a serious burden**. In the instant case, the Examiner was able to previously examine claims 1-43 (*see, e.g.*, Office Action mailed 12/14/00). Clearly in December 2000 it was not an undue burden to examine claims 1-43.

Now, the Examiner has refused to consider the arguments filed in the Amendment dated December 13, 2001, and instead provided a second restriction requirement.

Applicants respectfully request that the Examiner explain, for the record, just what has changed in this application to create an undue burden to examination where none previously existed. If this change reflects a change in Office policy, Applicants request that the Examiner identify the **Official Gazette** or **Federal Register** publication where this change in policy is announced and commentary on the change is requested.

In addition, Applicants request the Examiner explain, for the record, her refusal to address the amendments and substantive comments mailed on December 13, 2001.

Applicants further note that the Examiner's allegation that Applicants election was non-responsive is improper. The Office Action mailed on March 7, 2002 expressly states:

Applicant is required to elect **a single species** as it reads on a clone (*e.g.* C25, S25, C39, 1C6, 1F3 or any of the clones set forth in Table 4) or a particular combination of CDR and framework (*e.g.* VH, VL, and framework region 3). With regard to a particular combination, Applicant **should** specify them by nucleotides of SEQ ID NO.

In the response of May 3, 2002, Applicants stated:

Applicants elect s a species as it reads on clone C25. With respect to the listing of claims readable on the elected species, Applicants note that claims 1 and 24 are generic and that dependant claims 3, 6-12, 17-23, 25-30, 36-43, and 78 are readable on the elected species.

Applicants thus elected a species with precision and specificity equal to the identification of the species provided by the Examiner. Applicants thus clearly and properly elected a species (C25) for prosecution.

With respect to the SEQ ID NO, the Examiner failed to indicate that identification by SEQ ID NO was required rather than simply requested. Moreover, as noted above, the antibody of clone C25 is characterized by both a VH and a VL region and these regions are given by two SEQ ID NOS (SEQ ID NOS 63 and 87 respectively). Thus, the antibody of clone C25 is not identified by a single SEQ ID NO.

In view of the foregoing Applicants believe they have properly made an election of species and are fully responsive to the restriction requirement made in the communication of March 7, 2002. If the Examiner wishes to make yet another restriction or allege yet again that Applicants are non-responsive, Applicants request a telephone interview with Examiner, and the Examiner's SPE and/or Biotechnology Specialist to discuss the matter.

The undersigned attorney of record can be contacted at (510) 337-7871.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tom Hunter', with a long horizontal flourish extending to the right.

Tom Hunter
Reg. No: 38,498

Please type a plus sign (+) inside this box → **+**

(Approved for use through 10/1/2000. OMB 0651-0031)
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/144,886
Filing Date	August 31, 1998
First Named Inventor	James D. Marks
Group Art Unit	1645
Examiner Name	Nita M. Minnifield
Attorney Docket Number	407T-895100US

Total Number of Pages in This Submission

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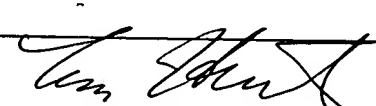
ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below): receipt acknowledgment postcard
<input checked="" type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)		
<input checked="" type="checkbox"/> Extension of Time Request		
<input type="checkbox"/> Express Abandonment Request		
<input type="checkbox"/> Information Disclosure Statement		
<input type="checkbox"/> Certified Copy of Priority Document(s)		
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

Authorization to Charge Deposit Account
Please charge Deposit Account No. 50-0893 for any additional fees associated with this paper or during the pendency of this application, including any extensions of time for consideration of the documents enclosed.

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

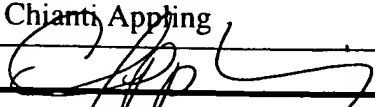
Firm or Individual name	Tom Hunter, Reg. No. 38,498, Quine Intellectual Property Law Group P.C.
Signature	
Date	October 30, 2002

CERTIFICATE OF MAILING

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Typed or printed name Chianti Appaling

Signature



Date

10/30/02

FEE TRANSMITTAL**for FY2002** NOV 04 2002Patent fees are subject to annual revision.
Small Entity payments must be supported by a small entity statement
otherwise large entity fees must be paid. See Form PTO/SB/08-02.

Complete if Known

TOTAL AMOUNT OF PAYMENT (\$)

Application Number	09/144,886
Filing Date	August 31, 1998
First Named Inventor	James D. Marks
Examiner Name	Nita M. Minnifield
Group / Art Unit	
Attorney Docket No.	407T-895100US

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METHOD OF PAYMENT (check one)

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number: 50-0893
 Deposit Account Name: Quine Intellectual Property Law Group, P.C.

- ☒
- Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

- 2.
- ☐
- Payment Enclosed:

☐ Check ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
101 740	201 370	Utility filing fee	
106 310	206 155	Design filing fee	
107 480	207 240	Plant filing fee	
108 690	208 345	Reissue filing fee	
114 150	214 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES

Extra Claims Fee from below Fee Paid

Total Claims - 20** = X =

Independent Claims - 3** = X =

Multiple Dependent =

**or number previously paid, if greater; For Reissues, see below

Large Entity Small Entity

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
103 18	203 9	Claims in excess of 20
102 84	202 42	Independent claims in excess of 3
104 280	204 140	Multiple dependent claim, if not paid
109 78	209 39	** Reissue independent claims over original patent
110 18	210 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
105 130	205 65	Surcharge - late filing fee or oath	
127 50	227 25	Surcharge - late provisional filing fee or cover sheet	
139 130	139 130	Non-English specification	
147 2,520	147 2,520	For filing a request for reexamination	
112 920*	112 920*	Requesting publication of SIR prior to Examiner action	
113 1,840*	113 1,840*	Requesting publication of SIR after Examiner action	
115 110	215 55	Extension for reply within first month	
116 400	216 200	Extension for reply within second month	200.00
117 920	217 460	Extension for reply within third month	
118 1,440	218 720	Extension for reply within fourth month	
128 1,960	228 980	Extension for reply within fifth month	
119 320	219 160	Notice of Appeal	
120 300	220 150	Filing a brief in support of an appeal	
121 260	221 130	Request for oral hearing	
138 1,510	138 1,510	Petition to institute a public use proceeding	
140 110	240 55	Petition to revive - unavoidable	
141 1,280	241 640	Petition to revive - unintentional	
142 1,280	242 640	Utility issue fee (or reissue)	
143 430	243 215	Design issue fee	
144 580	244 290	Plant issue fee	
122 130	122 130	Petitions to the Commissioner	
123 50	123 50	Petitions related to provisional applications	
126 180	126 180	Submission of Information Disclosure Stmt	
581 40	581 40	Recording each patent assignment per property (times number of properties)	
146 690	246 345	Filing a submission after final rejection (37 CFR 1.129(a))	
149 690	249 345	For each additional invention to be examined (37 CFR 1.129(b))	

Other fee (specify) _____

Other fee (specify) _____

Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 200.00

SUBMITTED BY

Typed or Printed Name: Tom Hunter

Signature: 

Date: 10/30/02

Complete (if applicable)

Reg. Number: 38,498

Deposit Account User ID: _____

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